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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,912	03/31/2004	Huddec Jacob Ho	MNOAP008	9310
23689	7590	10/30/2007		
Jung-hua Kuo Attorney At Law PO Box 3275 Los Altos, CA 94024			EXAMINER TRUONG, KEVIN THAO	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 10/30/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No. **10/815,912**Applicant(s) **HO ET AL.**

Examiner

Kevin T. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Election 10/04/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 6-11, 13, 14 and 30-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, and 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of figures 4A-4B. Note that Examiner only found claims 1-5, 12, and 15-25 are readable on the elected species 4A-4B instead of claims 1-5 and 12-29 as pointed out by Applicant's election in the reply filed on 10/04/2007 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 12, and 15-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US 2003/0163129 A1)

The applied reference has a common Assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Lee et al discloses a probe defining a probe axis; a cutting loop configured to be in one of a storage configuration and a cutting configuration; and a loop holder defining a loop holder axis generally orthogonal to the probe axis, the loop holder being configured to hold and to rotate the cutting loop about the loop holder axis when the cutting loop is in the cutting configuration so as to adjust a loop angle defined between the probe axis and the cutting loop; wherein the probe includes a probe cover slidable along the probe axis and having a distal position in which the probe cover houses at least part of the loop holder and the cutting loop in the storage configuration and a proximal position in which at least part of the loop holder and the cutting loop are external to the probe cover and in which the cutting loop is in the cutting configuration; wherein the cutting loop is configured in the storage configuration when retracted into the probe and when extended from a distal region of the probe, the cutting loop generally returning to a cutting configuration from the storage configuration; a handle coupled to a proximal region of the probe, the handle housing a loop controller for at least one of selectively extending the cutting loop to the cutting configuration out of the probe and retracting the cutting loop to the storage configuration within the probe, and selectively rotating the loop holder and the cutting loop when the cutting loop is in the cutting configuration; wherein the cutting loop has at least one of high elasticity, shape memory property and superelastic property; wherein the cutting loop is fixedly attached to the loop holder; an energy source operatively coupled to the cutting loop; wherein energy provided by the energy source is selected from the group consisting of radio frequency, laser, ultrasound, heat, cold, oscillation, vibration, rotation, liquid pressure

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and gas pressure; wherein the rotation or oscillation is generally in a direction orthogonal to the probe axis; at least one gear disposed in at least one of the loop holder and the probe, the at least one gear being configured to at least one of rotate and oscillate the cutting loop; wherein the cutting loop includes a metallic material such that the metallic material is one of titanium, titanium alloy, nickel-titanium alloy, nickel-chromium alloy, chromium-nickel alloy, cobalt chromium-nickel alloy and iron-chromium alloy; wherein the probe includes at least one accessory channel; and furthermore, wherein the at least one accessory lumen includes at least one of a transport lumen configured to transport a material to be to a distal end of the probe and a vacuum lumen operatively connected to a vacuum source.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 12, and 15-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Burbank et al. (US 6,331,166).

Burbank et al discloses in figures 1-10, a probe (30) defining a probe axis (19); a cutting loop (20) configured to be in one of a storage configuration and a cutting configuration; and a loop holder (14,16) defining a loop holder axis generally orthogonal to the probe axis (19), the loop holder (14,16) being configured to hold and to rotate the cutting loop (20) about the loop holder axis when the cutting loop (20) is in the cutting configuration so as to adjust a loop angle defined between the probe axis and the cutting loop; wherein the probe (30) includes a probe cover (at 18) slidable along the probe axis and having a distal position in which the probe cover (at 18) houses at least part of the loop holder (when the loop holder fully retracted within the probe (30)) and the cutting loop in

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the storage configuration and a proximal position in which at least part of the loop holder (14,16) and the cutting loop (20) are external to the probe cover and in which the cutting loop is in the cutting configuration; wherein the cutting loop is configured in the storage configuration when retracted into the probe and when extended from a distal region of the probe, the cutting loop generally returning to a cutting configuration from the storage configuration; a handle (at 24) coupled to a proximal region of the probe, the handle housing a loop controller for at least one of selectively extending the cutting loop to the cutting configuration out of the probe and retracting the cutting loop to the storage configuration within the probe, and selectively rotating the loop holder and the cutting loop when the cutting loop is in the cutting configuration; wherein the cutting loop has at least one of high elasticity, shape memory property and superelastic property; wherein the cutting loop is fixedly attached to the loop holder; an energy source operatively coupled to the cutting loop; wherein energy provided by the energy source is selected from the group consisting of radio frequency, laser, ultrasound, heat, cold, oscillation, vibration, rotation, liquid pressure and gas pressure; wherein the rotation or oscillation is generally in a direction orthogonal to the probe axis; at least one gear disposed in at least one of the loop holder and the probe, the at least one gear being configured to at least one of rotate and oscillate the cutting loop; wherein the cutting loop includes a metallic material such that the metallic material is one of titanium, titanium alloy, nickel-titanium alloy, nickel-chromium alloy, chromium-nickel alloy, cobalt chromium-nickel alloy and iron-chromium alloy; wherein the probe includes at least one accessory channel; and furthermore, wherein the at least one accessory lumen includes at least

one of a transport lumen configured to transport a material to be to a distal end of the probe and a vacuum lumen operatively connected to a vacuum source.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huang et al. (US 5,133,713) discloses a prostatectomy device having cutting loop.

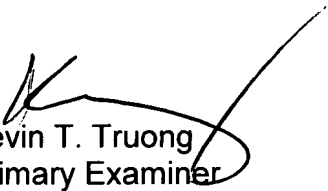
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin T. Truong whose telephone number is 571-272-4705. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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